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Docket No. 48002-DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: P. Rhode et al.  
SERIAL NO. 09/766,378 Examiner: Dr. A. DeCloux  
FILED: August 31, 2001 Group Art Unit: 1644  
FOR: SOLUBLE MHC COMPLEXES AND METHODS OF USE THEREOF

#5  
JW  
5/13/02

THE HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS  
WASHINGTON, DC 20231

SIR:

**RESPONSE TO RESTRICTION REQUIREMENT**

Applicants are in receipt of the Restriction Requirement dated March 26, 2002 for the above-referenced application.

Applicants respectfully request reconsideration of the Restriction Requirement. The Restriction Requirement lists *over 40 separate groups*. Clearly, huge expense and time will be imposed on Applicants if separate divisional applications must be pursued for each of the *40-plus groups*.

Moreover, such an extensive Restriction was not imposed in the parent application, now issued U.S. Patent 6,232,445. Two groups were identified in that parent application. A copy of the Restriction Requirement from the parent application is enclosed.

It is also believed that the search and examination for many of the groups specified in the Restriction of the present application would be substantially co-extensive, particularly in view of the search and examination that already has been conducted for the parent case, U.S. Patent 6,232,445.

For such reasons, Applicants respectfully request that multiple groups be considered together at this time, particularly Groups IX through XXII, as those groups are defined in the

Office letter. As a further proposal, Applicants would urge that Groups XVIII, XI, XII, and XIX be considered together at this time.

To provide a complete response, however, Applicants elect Group XVIII as that group is defined in the Office letter. As a species, Applicants elect the molecule shown in Figure 9B of the application. Claims that read on that species include claims 25 through 29.

Respectfully submitted,



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**Office Action Summary**

MAY 06 2002

Application No.  
08/960,190

Applicant(s)

Rhode et al.

Examiner

Thomas Cunningham

Group Art Unit

1644

☒ Responsive to communication(s) filed on Jul 6, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1-37 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-37 are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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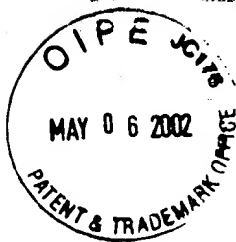
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Serial Number: 08/960,190

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-29, drawn to MHC Class polypeptide products, classified in class 530, subclass 395.
  - II. Claims 30-37, drawn to nucleic acids, vectors and recombinant DNA-based manufacturing methods, classified in class 536, subclass 23.5 and class 435, subclasses 69.1, 320.1 and 252.3.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are have different functions, structures and effects as they are directed to structurally and functionally distinct polypeptides or nucleic acids.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. Upon election of either one of the inventions above, a further election of an ultimate, structurally-defined species of polypeptide or nucleic acid product is required. Claims 1-37 are generic to a plurality of disclosed patentably distinct species comprising structurally and

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functionally distinct polypeptides or nucleic acids. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. In the event of an election of Group I, Applicant should specify every component of the elected species of MHC Class II product. For instance, whether the elected species of product is a single chain, or a complex, if a complex then the identity of each component of the elected species of complex must be specified. Applicant must also specify the identity of any substitutions made to the elected species of MHC Class II chain, its length, its arrangement, whether it comprises a binding groove, and whether it encompasses a linker (or other covalently-linked moiety).

Similarly, in the event Group II is elected, Applicant must indicate the specific structural identity of the MHC Class I component the elected species of DNA encodes.


Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Cunningham, Ph.D., J.D. whose telephone number is (703) 308-3968.

  
THOMAS M. CUNNINGHAM  
PRIMARY EXAMINER  
GROUP 1800